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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91182064
Party	Plaintiff AS Holdings, Inc.
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Attachments	Opposer's Memo in Opposition to Applicant's Motion to Substitute Expert Witness.pdf (5 pages)(198424 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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AS HOLDINGS, INC.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91182064
)	
H&C MILCOR, INC. f/k/a)	
AQUATICO OF TEXAS, INC.)	Serial Number: 76/461,157
)	Mark: Miscellaneous Design:
Applicant.)	(Pipe Boot Product Design)
)	

**OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION
TO SUBSTITUTE AN EXPERT WITNESS AND TO EXTEND TIME
FOR EXPERT'S REPORT**

Applicant's motion to substitute a new expert witness in this action is insufficient in view of the Order of April 3, 2009 and should be denied. In its Order of April 3, 2009, the Board granted Opposer another extension of time to file expert disclosures for its previously identified experts that were in compliance with the Rules. It is now clear that Applicant had in essence filed a list of purported experts as "place holders" which was not in compliance with the Rules, which bought Applicant time to shop for an expert witness that Applicant may actually wish to use in this proceeding. This is not appropriate, particularly in view of the manner in which Applicant's original listing of experts arose.

I. Background

The original expert disclosure deadline expired August 31, 2008 with Opposer failing to identify experts or produce reports. Although both parties understood that the expert disclosure deadline had long since expired, the period for expert disclosures was subsequently reopened and extended to October 30, 2008 by virtue of a computer-generated Order dated September 29, 2008, despite the lack of any express rule stating that periods for expert disclosures are to be

reopened upon the filing of a motion to extend a discovery period under 37 CFR 2.127.

Applicant took advantage of this computer-generated order and filed a Notice of Expert Witnesses on October 3, 2008. Opposer brought this issue to the Board's attention in a Reply Brief dated October 10, 2008.¹

The Board subsequently issued its Order of April 3, 2009 granting Applicant an additional thirty (30) days in which to file a supplemental expert disclosure including a written report "for each expert identified in applicant's *initially served* expert disclosure, failing which applicant's expert disclosure *as originally served* will be deemed *insufficient* and applicant *will be precluded* from introducing expert testimony at trial." (emphasis added)

Applicant had previously filed its Notice of Expert Witnesses (i.e. the "initially served expert disclosure") on October 3, 2008, in which Applicant identified George Creil, Thomas Kelly, and Ronald W. Resech as expert witnesses in this action. Six months had elapsed when the parties received notice of the Board's Order of April 3, 2009 granting an additional thirty days in which to file a supplemental expert disclosure including a written report.

Applicant, in its motion dated April 29, 2009, now requests an additional thirty (30) days in which to file an expert's report, and further, proposes to substitute an expert witness because (1) Mr. Creil has refused to serve "for some unknown reason," (2) Mr. Kelly "has been traveling for the last month and has not had sufficient time to review the extensive materials," and (3) Mr. Resech has a legal conflict with Applicant.

¹ Opposer understands that the recent changes in the Rules applicable to the Trademark Trial and Appeal Board are in their infancy and interpretation issues are in the process of being addressed as the issues arise. Opposer makes note of this background, not as an effort to revisit the Board's ruling on the prior motion, but to point out that Applicant has already taken advantage of Opposer's willingness to be cooperative in a short extension of the discovery period and the Board has already been lenient in extending the period for Applicant to comply with the Rules.

II. Discussion

Opposer cannot opine as to the reasons why Mr. Creil and Mr. Resech have now decided to make themselves unavailable to Applicant. However, Opposer respectfully submits that the seven (7) months that elapsed between Applicant's Notice of Expert Witnesses and the May 2, 2009 deadline to file a supplemental expert disclosure including a written report, have been more than adequate and reasonable for Mr. Kelly to review the materials that are pertinent to this action, regardless of whether he had been traveling during the month preceding Applicant's motion of April 29, 2009.

Further, Opposer is at a loss to understand why yet another thirty day extension would be sufficient for Applicant's newly proposed substitute expert, Mr. Philip D. Dregger, to review the materials associated with this action, while the same thirty days would be insufficient for Mr. Kelly, who has presumably been aware of this action for over seven months. In particular, under the Rules Mr. Kelly should have reviewed the materials related to the case and been prepared to file a written expert report in compliance with the Rules back in October 2008. Applicant's motion appears to be little more than an indication that the expert witnesses named in its Notice of October 3, 2008 were merely used to create the appearance of compliance and to obtain even more time for selecting a witness that Applicant prefers.

Both the Board and Opposer have been very accommodating of Applicant's previous motions to extend discovery. However, it appears that Applicant is attempting to take advantage of previous accommodations to further delay and/or avoid fulfilling its duties in this action. In addition, the Order of April 3, 2008 was explicit in stating that for each expert identified in Applicant's expert disclosure of October 3, 2008 (i.e. Mr. Creil, Mr. Kelly, and Mr. Resech), a supplemental expert disclosure including a written report would be required by May 2, 2009,

failing which applicant's expert disclosure as originally served will be deemed insufficient and applicant will be precluded from introducing expert testimony at trial. By failing to file a supplemental expert disclosure including a written report for any of the experts identified in Applicant's expert disclosure of October 3, 2008, Applicant has once again declined to comply with the Board's explicit requirement.

III. Conclusion

Applicant should not be permitted to once again fail to comply with the Board's requirements and dates, and Applicant's motion should be denied. In view of Applicant's failure to comply with the Board's Order of April 3, 2009, Applicant should be precluded from introducing expert testimony at trial.

Respectfully submitted,



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Dated: May 7, 2009

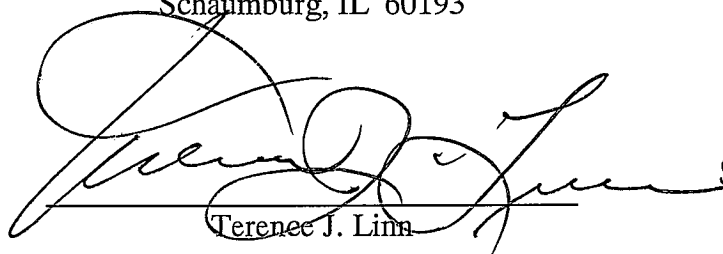
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CERTIFICATE OF SERVICE

I hereby certify that on May 7, 2009, a true and correct copy of Opposer's Memorandum in Opposition to Applicant's Motion to Substitute an Expert Witness and to Extend Time For Expert's Report was sent via First Class Mail, postage prepaid to Attorney for Applicant as follows:

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